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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,606	07/13/2001	Odile Aubrun-Sonneville	210237US0	2212
22850	7590	07/01/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			WELLS, LAUREN Q	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1617	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,606	Applicant(s) AUBRUN-SONNEVILLE ET AL.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-48 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15-20 and 22-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-13, 15-48 are pending. Claims 7 and 21 are withdrawn from consideration, as they are directed toward non-elected subject matter.

The Amendment filed 5/30/03, amended claims 15, 38, and 39, and added claims 40-48.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 5/30/03 and the declaration filed 6/3/04 to the rejection of claims 1-13, 15-16, 18-20 and 22-39 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Amendment to the claims filed 5/30/03, is sufficient to overcome the 35 USC 112 and 102 rejections in the previous Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 15-16, 18-20, 22-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronson et al. (4,606,913) in combination with the Proceedings of the 5th World Surfactants Congress, Volume 2 (Proceedings).

The instant claims are directed toward water in oil emulsions comprising an oligomeric or polymeric emulsifier comprising I) a polyolefinic apolar component comprising at least 40 carbon atoms and ii) at least one polar component, wherein said oily phase comprising at least

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one hydrocarbon oil and said at least one oil is present in an amount of at least 40% by weight relative to the total weight of the oily phase.

Aronson et al. is directed to high-internal phase emulsions (title and abstract). The emulsions can be water-in-oil (col. 5, lines 28-29). For hydrocarbon oils see column 6, lines 40-1. At col. 6, lines 52-52 it is taught that the amount of oil is not critical. Therefore, absent evidence of unexpected results the instantly claimed concentration range of at least 40 wt% hydrocarbon oil in the oily phase is not given patentable weight. The amount of oily phase in water-in-oil emulsions is about 2-24% by volume (col. 6, lines 57-68). The amount of aqueous phase in water-in-oil emulsions is usually about 76-98% by volume (col. 7, lines 7-13). Fatty acids and fatty alcohol esters, inter alia, are disclosed under the Cosmetic Adjunct Materials bridging columns 17 and 18. The emulsions are made by adding an emulsifier to the oil phase and then adding the aqueous phase to the oil phase (col. 18, line 58-col. 19, line 4). For the emulsifier comprising 0.5-4% of the emulsion, see col. 6, lines 8-18.

Aronson et al. does not teach an emulsifier as instantly claimed. The Proceedings teach that alkenyl succinic anhydride emulsifiers made with polyisobutylene provide very stable water-in-oil high internal phase emulsions for use in personal care products (abstract, introduction and chemistry). The formula provided under the Chemistry section discloses that R is a hydrocarbon chain having from 12-150 carbons, which encompasses Applicants instantly claimed range of carbon atoms in the polyolefinic apolar component.

It is with in the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. In re Boesch, 205 USPQ 215 (CCPA 1988). It would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the

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proportions of components in a composition to arrive at the best compositions for the intended purpose. "it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(in banc). Therefore, absent evidence of unexpected results, the concentration ranges of components instantly claimed is not given patentable weight.

The limitation of claim 4 regarding the ability of the emulsifier to reduce the interfacial tension between the aqueous and oily phases is an inherent property of the emulsifier. The prior art teaches emulsions containing the same components instantly claimed and the emulsifier instantly claimed. One of ordinary skill in the art would expect the same emulsifier to exhibit the same properties, absent evidence to the contrary. Burden is shifted to Applicant to show that the prior art emulsifier does not exhibit the properties instantly claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the high internal phase water-in-oil emulsions of Aronson et al. using the polyisobutylene succinic anhydride emulsifier of the Proceedings because of the expectation of achieving excellent stability and a variety of textures of the emulsions.

It is respectfully pointed out that for the purposes of searching for an applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior

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art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. See MPEP 2111.03.

Response to Arguments

Applicant argues, "Proceedings related to a conference apparently held May 29-June 2, 2000, in Italy. However, there is no indication when the Proceedings publication ^{became} ~~because~~ publicly available, let alone evidence showing that the publication became publicly available more than 1 year prior to the present application's US filing date". This argument is not persuasive. First, Proceeds is the summary of an oral presentation, wherein it is stated that at the time of the presentation, their compounds, i.e., the claimed emulsifiers, found were utilized in skin and hair care products, which indicates their public use. Second, even if this publication is not 102(b) art, the presentation still meets the requirements of 102(a).

The Rule 131 declaration submitted by Applicant, wherein Applicant attempts to predate the Proceedings is not persuasive. The notebook pages filed as evidence of the instant invention's effective date prior to May 29, 2000, are in French. The Examiner is unable to read French, and is therefore unable to evaluate Applicant's claim of invention prior to 5/29/2000. For this reason alone, the instant declaration is defective and not being considered.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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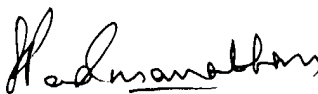
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER